

60,130-1118
01MRA0235REMARKSClaim Rejections - 35 U.S.C. §103

The Examiner rejected claims 2, 3, 5-7, 13-15, 18 and 21 pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,091,679 to *Murty, et al.* in view of JP-4300709. In addition, the Examiner also rejected claims 2, 3, 5-7, 13-15 and 18 pursuant to 35 U.S.C. §103(a) as being unpatentable over JP-4300709 in view of *Murty et al.* Claims 8 and 16 were rejected under 35 U.S.C. §103(a) over JP-4300709 in view of *Murty et al.* and further in view of *McGee* (U.S. 3,513,408) and over *Murty et al.* in view of JP-4300709 and *McGee*. Claims 9 and 10 were rejected under 35 U.S.C. §103 over JP-4300709 in view of *Harris* (U.S. 6,005,316). Moreover, claim 17 was rejected under §103(a) over JP-4300709 in view of *Murty et al.* and in view of *Harris*. Finally, the Examiner rejected claims 9, 10, and 17 as obvious over *Murty et al.*, JP-4300709 and in view of *Harris*. Applicant disagrees with the basis for the rejection and believes all of its currently pending claims, claims 2, 3, 5-10, 13-18 and 21, to be in condition for allowance.

As to the rejection of claims 2, 3, 5-7, 13-15 18 and 21, the combination of *Murty et al.* and JP-4300709 is improper. There is no teaching, suggestion or motivation for their combination. As a preliminary matter, the Applicant appreciates the Examiner's ordering of a certified translation of JP-4300709. However, the Examiner's continued reliance upon this reference is not supportable under the law. See *Ex parte Gavin*, 62 USPQ 2d 1680 (BPAI 2001).

In addition, the Examiner apparently continues to rely upon two motivations for the combination. First, the Examiner contends that it would have been obvious to one of

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ordinary skill in the art to have modified the magnetic element and coil assembly of *Murty, et al.* to have included a magnetic plunger and coil assembly, as taught by JP-4300709, "to provide a simpler shock absorber apparatus that eliminates the need for a rotary-to-linear converter." [Non-Final Office Action (3-25-04), p.3]. Applicant contends that replacing the dynamoelectric machine of *Murty, et al.* with a simple plunger and coil will defeat an objective of *Murty, et al.* In responding to Applicant's arguments, the Examiner argues that "Murty teaches that position sensors provide signals of the magnitude and direction of relative sprung mass/unsprung mass velocity." [Non-Final Office Action (3-25-04), p.3]. Yet, Murty also indicates that these position sensors are "rotor position sensors" of the dynamoelectric machine and that it is otherwise difficult to rely upon sensors other than the sensors of the dynamoelectric machine. [*Murty et al.*, column 8, l. 43 - column 9, l. 25]. Hence, replacing the dynamoelectric machine of *Murty et al.* with the plunger of JP'709 continues to defeat a purpose of the invention of *Murty et al.* For this reason, the combination is improper.

The Examiner alternatively seeks to combine JP-4300709 in view of *Murty et al.*, contending that this combination is proper "to provide a means of energizing the conductive coil as taught by Murty, et al., in col. 5 lines 52-55." [Non-Final Office Action (3/25/04), p. 4]. Yet, the Examiner fails to find support for this motivation in either reference. Instead, the Examiner identifies portions of *Murty et al.* describing a battery for storing energy. However, there is still no suggestion of the desirability of the combination of such a battery with the plunger assembly of JP '709. Accordingly, the combination of these references is improper. Because each of the rejections raised by the

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Examiner depends upon this combination, claims 2, 3, 5-7, 13-15, 18 and 21 stand in condition for allowance.

Claims 7 and 15 has been amended to require "said circuit comprises a switching circuit configured to control current to at least one of said coil and said battery." This feature is not shown by Figure 4 of *Murty, et al.* As noted previously, the circuit referred to as circuit 20, 22, 24, 26, 28, 30 is identified as a bridge, not a switching circuit. [*Murty, et al.*, column 5, ll. 56-61]. The Examiner contends that because these elements include transistors, the circuit can be broadly construed as a switching circuit. However, now as amended, claims 7 and 15 require the switching circuit to control current to at least one of said coil and said battery. Because the references fail to disclose this feature, these claims are allowable.

Claims 8 and 16 require further that "said switching circuit includes a field effect transistor." The Examiner seeks to supply this missing element with the field effect transistor of *McGee*. However, there is no suggestion, motivation or teaching of this combination in the cited references. The Examiner argues that Applicant has attacked *McGee* individually rather than in combination with the other references. The Examiner is mistaken. Rather, applicant has sought to demonstrate there is no reason one of ordinary skill in the art would seek to combine *McGee* with JP '709. The Examiner argues that such a combination is proper "to provide a device that occupies minimum real estate and that provides the advantage of a fast response time." [Non-Final Office Action (3/25/04), p. 5]. Yet, the Examiner fails to identify her support for this so-called motivation. Indeed, there is no suggestion of the desirability for the combination set forth in either reference. Therefore, claims 8 and 16 are allowable.

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Claim 9 requires in pertinent part, "said switching circuit switches at a higher frequency than the frequency of movement of said magnetized plunger." The Examiner contends that *Harris* teaches the cited feature of claim 9. In the referenced portion of *Harris* identified by the Examiner as support for her position, there is no mention of a switching circuit switching at a higher frequency than the frequency of movement of a magnetized plunger. Accordingly, the combination of JP-4300709 and *Harris* does not teach all of the limitations of claim 9. The Examiner does not address this argument in her Non-Final Office Action (3/25/04). Therefore, claim 9 is in condition for allowance.

In addition, the combination is improper. The Examiner contends that motivation exists to combine JP '709 with *Harris*, "to provide a means of accurately controlling the position of the magnetized plunger to assist in carrying out the active suspension control function." This so-called motivation, however, is not to be found in the cited references. The Examiner essentially manufactures a motivation, claiming that "providing a means of maintaining or adjusting the position of the magnetized element would be beneficial in efficiently effecting the active suspension control." [Non-Final Office Action (3/25/04), p. 12]. This motivation is not found in either reference. Accordingly, it cannot support the combination. For this additional reason, claim 9 is in condition for allowance.

Claim 10, which depends upon claim 9, requires "wherein a control senses movement of said vehicle support and selectively actuates said coil when it is desired to resist movement of said vehicle support." The Examiner identifies element 16 of JP '709 as such a control without citing to any translated portion of this reference. It is improper for the Examiner to rely on this untranslated portion of the Japanese reference. For this reason, claim 10 is in condition for allowance.

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For the reasons stated above, claims 2-3, 5-10, 13-18 and 21 are in condition for allowance.

Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on June 22, 2004.


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